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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,470	06/25/2001	Prabhakar Gopalan	AUS920010555US1	3831
45371	7590	09/25/2006	EXAMINER	
IBM CORPORATION (RUS) c/o Rudolf O Siegesmund Gordon & Rees, LLp 2100 Ross Avenue Suite 2600 DALLAS, TX 75201			AKINTOLA, OLABODE	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/888,470	Applicant(s) GOPALAN, PRABHAKAR	
	Examiner Olabode Akintola	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/25/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Abstract

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In the instant application, the abstract exceeds 150 words in length.

Specification

The disclosure is objected to because of the following informalities: The description of the drawings on page 3 of the disclosure does not correlate with the figure numbers cited in the accompanying drawings. Description Figures 6 is missing and also Figure 4 described as a flow chart in the disclosure, does not constitute a flow chart in the accompanying drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to an apparatus, but the body of the claim discusses the specifics of a process (“ wherein responsive to receipt of a primary number and a wallet number.....”). A claim is considered indefinite if it does not apprise those skilled in the art of its scope. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F. 2d 1200, 1217 (Fed. Cir. 1991).

Also, it is not clear how an apparatus may comprise of plurality of computers and a network as recited in claim 1.

Claims 2-8 are rejected as being dependent on claim 1 as discussed above.

Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 14 recites a computer readable memory comprising a storage medium. It is not clear how a memory can comprise of a storage medium. Rather, a storage medium may comprise of memory. Also, it is not clear how a “storage medium, so configured by the computer

program” can conduct a financial transaction without the execution of the program on the readable medium.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: relationship between the first computer and the second computer; relationship between the network and the first computer.

Claims 2-8 are rejected as being dependent on claim 1 as discussed above

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The acronym “CPDB” as applied in the claims is indefinite. The meaning of the term CPDB should be expressly recited in at least the independent claim.

Claims 9-10 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 9 recites completing a financial transaction in the preamble, but the body of the claim does not achieve this result.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing an apparatus (ex. Preamble of claims 1), the body of the claim discusses the specifics of the process ("wherein responsive to receipt of a primary number and a wallet number...") (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only", Ex parte Lyell (17USPQ2d 1548).

For examination purpose, the examiner will give these claims their broadest interpretation and treat them as apparatus claims.

Claims 9-10 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter.

Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a “useful, concrete and tangible result.” See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of “real world” value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

Independent claim 1 recites a limitation “obtaining a wallet number; providing a merchant with a

primary number and the wallet number” . However, these steps are not concrete and tangible. Specifically, for the aforementioned steps to be concrete they must have a result that can be substantially repeatable or the steps must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864 (Fed. Cir. 2000) (Where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). It is not clear what the repeatable and predictable result would be to provide a merchant with a primary number and the wallet number. Also, it is not clear what the tangible result would be upon providing a merchant with a primary number and the wallet number. Therefore, claimed invention(s) when viewed as a whole fail to produce a useful, concrete and tangible result and therefore is analyzed as non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Arent (USPN 6018724) (Arent).

Re claim 1: Arent teaches a programmable apparatus comprising: a first computer; a CPDB in the first computer (Col. 7, lines 38-42); a network (col. 8, lines 27-35); a second computer connected to a server computer by the network (col. 8, lines 58-67).

Examiner notes: The limitation “wherein responsive to receipt of a primary number and a wallet number from the second computer, a payment transaction is processed by the CPDB and the results transmitted to the second computer” are treated as intended use of the apparatus. The examiner notes that the intended use (or field of use) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Re claim 2: Arent teaches a transaction program in the CPDB (col. 3, lines 15-27).

Re claim 3: Arent teaches a wallet number generation program in the CPDB (col. 6, lines 29-31, Fig. 8 RN {816})

Re claim 4: Arent teaches a user database in the CPDB with account data to implement the payment transactions (col. 9, lines 61 – col. 10, line 22).

Re claim 5: Arent teaches a display of the primary number and the wallet number (col. 17, lines 19-30; col. 20, lines 32-37).

Re claim 7: Arent teaches a wallet set up program in the CPDB (col. 11, line 53).

Re claims 6 and 8: Arent teaches comprising a display of the wallet number, an account number and a limit on an account (col. 16, lines 16-18; col. 17, lines 19-30; col. 20, lines 32-37).

Re claim 9: Arent teaches a method for remotely completing a financial transaction using a CPDB comprising the steps of: obtaining a wallet number (col. 6, lines 29-31, Fig. 8 RN {816}); providing a merchant with a primary number and the wallet number (col. 17, lines 19-30; col. 20, lines 32-37).

Re claim 10: Arent teaches the step of creating the wallet number (col. 6, lines 29-31, Fig. 8 RN {816}).

Re claim 11: Arent teaches the step of using the primary number and the wallet number in the transaction with a merchant (col. 17, lines 19-30; col. 20, lines 32-37; col. 20, lines 32-37).

Re claim 12: Arent teaches the step of selecting accounts to be accessed by a combination of the primary number and the wallet number (col. 20, lines 32-37).

Re claim 13: Arent teaches the step of placing a limit on an account that can be accessed by the primary number and the wallet number (col. 16, lines 16-18).

Re claim 14: Arent teaches a computer readable memory comprising: a computer readable storage medium; a CPDB in said computer readable memory; a computer program stored in said storage medium; wherein the storage medium, so configured by the computer program, conducts a financial transaction upon receipt of a correct primary number and wallet number combination (col. 20, lines 32-37).

Re claim 15: Arent teaches a wallet number generation program in the CPDB (col. 6, lines 29-31, Fig. 8 RN {816}).

Re claim 16: Arent teaches a wallet set up program in the CPDB (col. 11, line 53).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fisher (USPN 6957199) teaches a method and system for conducting authenticated business transactions.

Copella et al. (USPN 4852165) teaches a secure system for providing personal identifier (col. 5, lines 25-28)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA



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